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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/068,080	02/05/2002	Christian Fritz	06286-090002	7540
26161	7590	12/31/2003	EXAMINER	
FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110			SHAHNAN SHAH, KHATOL S	
			ART UNIT	PAPER NUMBER
			1645	

DATE MAILED: 12/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/068,080

Applicant(s)

FRITZ ET AL.

Examiner

Khatol S Shahnan-Shah

Art Unit

1645

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 December 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.Claim(s) objected to: None.Claim(s) rejected: 39 and 40.Claim(s) withdrawn from consideration: None.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Attachment to Advisory Action

1. Applicants' amendment and reply to a final office action under 37 CFR 1.116, received December 19, 2003 is acknowledged.

The proposed amendments will not be entered because they raise new issues that would require further consideration and/or search for the following reasons:

New claims 41-50 require both new search and new rejection. New claims now recite that the polypeptide is derived from pathogenic and non- pathogenic strains of *Streptococci* and also the claims now recite a fusion protein comprising the polypeptide fused to a transcription activation domain of transcription factor or a DNA binding domain of transcription factor.

The above limitations have not been considered in the first and final rejections by the examiner in the history of prosecution.

2. Claims 39-40 are pending in the application.

Information Disclosure Statement

3. Applicants' Information Disclosure Statement received February 05, 2002 is acknowledged. The references cited on form PTO-1449 have been considered by the examiner. An initialed copy of IDS is attached with this action.

Rejections Maintained

4. Rejection of claims 39-40 under 35 U.S.C. 112, second paragraph, made in paragraph 10, of the office action mailed 8/26/2003 is maintained.

Applicants' arguments filed November 27, 2002 have been fully considered and are not

persuasive.

Applicants have not amended the claims. Applicants argue that the language of claims 39 and 40 are clear. Applicants further argue the language recited in part (b) of both claims does not necessarily mean that any compound that binds the S-yneS polypeptide is an antibacterial compound. Rather, the language of part (b) of these claims makes clear that a compound capable of binding this essential polypeptide is a candidate antibacterial agent. With respect to claim 39, such a candidate antibacterial agent may or may not be tested further to investigate the agent's antibacterial properties. With respect to claim 40, a candidate antibacterial agent is further tested to confirm the agent's antibacterial properties.

It is the examiner's position that the language as recited in part (b) of claims specially claim 39 is unclear. How can one assume that if a compound binds to a polypeptide can be a candidate antibacterial agent without further testing that compound?

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khatol Shahnan-Shah whose telephone number is (703) 308-8896. The examiner can normally be reached from 7:30 AM - 4 PM on Monday through Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette F Smith, can be reached on (703) 308-3909. The fax phone number for the organization where this application or proceeding is assigned to is (703) 305-3014.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



Khatol Shahnan-Shah, BS, Pharm, MS

Biotechnology Patent Examiner

Art Unit 1645



RODNEY P. SWARTZ, PH.D
PRIMARY EXAMINER

December 26, 2003